



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/786,509

02/25/2004

Bradley A. Rose

WMS-039

3991

30223

7590

06/26/2008

NIXON PEABODY LLP
161 N. CLARK STREET
48TH FLOOR
CHICAGO, IL 60601-3213

EXAMINER

WONG, JEFFREY KEITH

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

06/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/786,509 | Applicant(s) ROSE, BRADLEY A. | |
| | Examiner Jeffrey K. Wong | Art Unit 3714 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7, 10-15, 17 and 20-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 10-15, 17, 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-5, 7, 10-15, 17, 20-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is nothing in the specifications disclosing of accumulating the awards in a credit meter, after revealing the one or more awards, continuing to display the selected objects and their associated awards intermingled with the unselected selectable objects in the first display image; and after completing the selection game, displaying a second display image distinct from the first display image that displayed the selected objects and their associated indicia intermingled with the unselected selectable objects, and the second display image replacing the first display image in whole or in part, the second display image presenting the selected objects and their associated awards in a first group in a first region, the second display image presenting the unselected objects and their associated awards in a second group in a second region separated from the first region, the first and second groups being segregated such that the objects previously intermingled in the first display image are no longer intermingled when in the respective

first and second groups in the second display image, at least some of the objects being relocated from the first display image to new locations in the second display image.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 4-5, 7, 15, 17 recites the limitation an indicia. There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5, 7, 10-15, 17, 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaminkow, US Patent Application Publication 2003/0100358A1 in view of Brossard et al., US Patent 6,364,767B1.

Regarding Claim 1, 7, 12, 17, 22-24.

(Currently Amended) Kaminkow discloses a method of conducting a wagering game, comprising:

conducting a selection game including displaying a plurality of intermingled selectable objects superimposed over a setting in a first display image(Fig 3A);

selecting one or more of the intermingled selectable objects;

revealing one or more awards associated with the selected objects;
accumulating the awards in a credit meter(para 41. A bonus meter displays the tallied multipliers or credits for the round);
after revealing the one or more awards, continuing to display the selected objects and their associated awards intermingled with the unselected selectable objects in the first display image(Fig 3B);

Kaminkow failed to disclose after completing the selection game, displaying a second display image distinct from the first display image that displayed the selected objects and their associated indicia intermingled with the unselected selectable objects, and the second display image replacing the first display image in whole or in part, the second display image presenting the selected objects and their associated awards in a first group in a first region, the second display image presenting the unselected objects and their associated awards in a second group in a second region separated from the first region, the first and second groups being segregated such that the objects previously intermingled in the first display image are no longer intermingled when in the respective first and second groups in the second display image, at least some of the objects being relocated from the first display image to new locations in the second display image

However, Brossard discloses of a bonus round which displays to players the final bonus combination and the prize provided as a portion of the bonus feature(Fig 7 and Fig 8). It should be noted that the figures depict the result of a player's choices and the associated award of said choices as a means of illustrating the predetermined results of

Art Unit: 3714

the bonus feature in an interesting fashion as well as showing the player the prize amount being indicative to the player's choices(Col 4, lines 50-60). The indicative award given to the player being displayed can be applied for displaying the awards the player did not receive from the unselected objects as well as the award give to players for the object chosen. The Examiner views the limitation described as a means of displaying to a player as a display of the award indicative of player's selection of an object as well as displaying the awards that are associated with one or more objects that were not selected by said player and believes Brossard discloses of such a limitation and the implementation of such a limitation as obvious because it pertains to analogous art.

Regarding Claims 2, 13.

(Original) Kaminkow discloses the method of claim 1, wherein the step of displaying the plurality of selectable objects occurs in a bonus game(Abstract. Play).

Regarding Claims 3, 14.

(Original) Kaminkow discloses the method of claim 1, wherein the step of displaying the plurality of selectable objects occurs in a basic game(Abstract). It is well known in the art that features found in bonus games can be implemented for basic games.

Regarding Claims 4.

(Previously Presented) Kaminkow discloses the method of claim 1, wherein said indicia

associated with the

selected objects is indicative of an award, an end bonus marker, or a trigger for another game feature(para 1. The bonus game has a bonus terminator).

Regarding Claims 5.

(Original) Kaminkow discloses the method of claim 1, wherein the step of revealing the one or more indicia

includes revealing the indicia in proximity to the respective selected objects(Abstract).

Regarding Claims 10, 20.

(Original) Kaminkow discloses the method of claim 1, wherein the first display image and the second display image are presented on a common display(para 30).

Regarding Claims 11, 21.

(Original) Kaminkow discloses the method of claim 1, wherein the first display image and the second display image are presented on different displays(para 30. There are multiple displays).

Regarding Claim 15.

(Original) Kaminkow discloses the apparatus of claim 12, wherein the controller is operative to reveal the indicia in proximity to the respective selected objects(Fig 3A, Fig

3B. It is obvious to one skilled in the art that the selectable objects and the revealed awards are proximate to one another).

Response to Arguments

7. Applicant's arguments with respect to claims 1, 12, and 22-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey K. Wong whose telephone number is (571)270-3003. The examiner can normally be reached on M-Th 8:30am-7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached on (571)272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/786,509
Art Unit: 3714

Page 8

/John M Hotaling II/
Primary Examiner, Art Unit 3714

JKW